REMARKS/ARGUMENTS

Claims 1-13 were pending. In the present response, Applicants has amended claims 1 and 9, leaving claims 1-13 pending in the present application for the Examiner's consideration. No new matter has been added.

In summary of the Office Action of May 5, 2005, the Examiner has:

I. Rejected Claims 1-3 and 6-13 under 35 U.S.C. § 103(a) as being unpatentable over MacPhail (U.S. Patent No. 5,179,718) in view of Khan (U.S. Patent No. 6,401,206); and

II. Rejected Claims 4-5 under 35 U.S.C. § 103(a) as being unpatentable over MacPhail in view of Khan and further in view of IBM "Technical Disclosure Bulletin".

Applicants respectfully traverse the Examiner's rejections.

I. Rejection of Claims 1-3 and 6-13 under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-3 and 6-13 as unpatentable over as being unpatentable over MacPhail (U.S. Patent No. 5,179,718) in view of Khan (U.S. Patent No. 6,401,206). Claim 1 recites in part:

> cryptographically securing the combination of the pages of at least two electronic documents of staple data object in response to receipt of the staple instruction, thereby creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time. (Emphasis Added)

Claim 9 recites a similar element. The Applicants respectfully submit that neither MacPhail nor Khan disclose or suggest this element.

There is nothing in MacPhail that discloses or suggests using cryptography or any other means to provide "an unalterable indicator of the existence and integrity of the association" of documents. According to MacPhail, "the staplee parameters are preserved within the document until the document is deleted from a document library or the document is unstapled by its last document." (MacPhail, Col. 6, lines 10-13) (Emphasis Added) . "The history option . . . is deleted when the document is unstapled by another document and created when the document

PAGE 10/13 * RCVD AT 9/6/2005 8:09:05 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/27 * DNIS:2738300 * CSID:415 576 0300 * DURATION (mm-ss):04-46

is stapled by another document." (MacPhail, Col. 6, lines 15-19) (Emphasis Added). Thus, users of MacPhail can freely delete documents from a staple relationship without leaving any evidence that the staple relationship previously existed.

MacPhail does disclose "specify[ing] a security level to associate within the document that is being filed" (Col. 4, Lines 56-64). This security level prevents unauthorized users from accessing a document. (Col. 4, Lines 56-64). However, the security level disclosed by MacPhail does not protect the association between "pages of at least two electronic documents," as recited by claim 1, let alone provide "an unalterable indicator of the existence and integrity of the association" of documents.

The Examiner cites the Abstract of Khan and Col. 11, lines 23-34, as teaching the use of cryptography. Applicants respectfully submit that Khan fails to disclose or suggest the use of cryptography for "creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time," as recited by claim 1.

Khan does not disclose that cryptography or a single indicator can be used to protect the integrity of the association of multiple documents. The cited portion of the abstract of Khan states "Document and digital identity verification including a verifying a cryptographic digital signature that establishes the integrity of the document." Similarly, column 11, lines 23-34 describe a process of "carry[ing] the electronic impressions, made by a digital identity on a given document, with the document itself using the conventional cryptographic systems."

In both cited portions, Khan clearly discloses that a single digital signature is used to protect the integrity of a single document. Khan does not disclose that a single digital signature can to protect the integrity of the association of multiple documents. In fact, Khan does not disclose or suggest associating multiple documents together for any purpose. Therefore, Applicants respectfully submit that Khan does not disclose or suggest cryptographically securing an object, "creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time," as recited by claims 1 and 9.

PAGE 11/13 * RCVD AT 9/6/2005 8:09:05 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/27 * DNIS:2738300 * CSID:415 576 0300 * DURATION (mm-ss):04-46

Because neither MacPhail nor Khan disclose or suggest cryptographically securing the combination of electronic documents, "thereby creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time," Applicants respectfully submit that claims 1 and 9, as well as their respective dependent claims, are patentable over the cited references.

II. Rejection of Claims 4-5 under 35 U.S.C. § 103(a)

The Examiner has rejected claim 4 and 5 as unpatentable over MacPhail and Khan in view of "IBM Technical Disclosure Bulletin." As discussed above, neither MacPhail nor Khan disclose or suggest cryptographically securing the combination of electronic documents, "thereby creating an unalterable indicator of the existence and integrity of the association of selected pages and selected documents together at one time," as recited by claim 1. Similarly, there is nothing in "IBM Technical Disclosure Bulletin" that discloses or suggests any need or means for protecting document integrity. Applicants therefore respectfully submit that claims 4 and 5 are patentable for this reason as well.

PAGE 12/13 * RCVD AT 9/6/2005 8:09:05 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/27 * DNIS:2738300 * CSID:415 576 0300 * DURATION (mm-ss):04-46

CONCLUSION

In view of the foregoing, Applicant believe all claims now pending in this Application are patentable and in condition for allowance and respectfully request an action to that end.

The Applicant invite the Examiner to contact the undersigned if he believes a telephone conference would expedite the prosecution of this application.

Respectfully submitted,

9/6/05
Date

Jonathan M. Hollander
Reg. No. 48,717

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
JMH:asb
60498639 v1

PAGE 13/13 * RCVD AT 9/6/2005 8:09:05 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/27 * DNIS:2738300 * CSID:415 576 0300 * DURATION (mm-ss):04-46